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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,476	09/05/2003	Carey E. Garibay	BEAS-01454US5	8634
23910	7590	03/23/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			AGWUMEZIE, CHARLES C	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,476

Applicant(s)

GARIBAY ET AL.

Examiner

Charlie C. Agwumezie

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/8/04; 03/11/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 17, 2006 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5, 7-10, 12-13, 16, 18, 19-21, 23-24, 27, 29-31, and 32, are rejected

under 35 U.S.C. 102(e) as being anticipated by Aldis et al U.S. Patent Application Publication 2004/0039916 A1.

1. As per **claim 1, 12 and 23**, Aldis et al discloses a method comprising:

maintaining a software license bank for a customer, software licenses stored in the software license bank not being associated with specific machines (fig.1 and 11; 0013, 0014, 0018, claim 61); and

accessing a web application to allow a user to automatically obtain a software license for a specific machine from the software license bank, wherein the software license is associated with a first license key (figs.1, 6 and 7; 0014, 0016, 0017, 0018, 0021, 0023, 0061, 0153).

upgrading/downgrading software associated with first license key including obtaining a second license key and disabling the first license key (0099; 0100; 0105; 0119).

2. As per **claim 2, 13 and 24**, Aldis et al further discloses the method, wherein the software licenses available from the software license bank depend on a predetermined contract (0022).

3. As per **claim 5, 16 and 27**, Aldis et al further discloses the method, wherein the software license bank contains an unlimited number of licenses for some period of time (fig. 2 and 4, 0078).

4. As per **claim 7, 18 and 29**, Aldis et al further discloses the method, wherein the web application maintains digital records of software licenses, the digital records indicating rights associated with the software licenses (fig. 2, and 4, 0005, 0015, claim

Art Unit: 3621

79).

5. As per claim 8, 19 and 30, Aldis et al further discloses the method, wherein web application can be used to adjust the rights associated with the software license (0022, 0069, 0097).

6. As per claim 9, 20 and 31, Aldis et al further discloses the method, wherein the web application is used to provide license keys for the software (see figs. 2 and 19, 0077, 0087, claim 40).

7. As per claim 10, 21 and 32, Aldis et al further discloses the method, wherein the web application uses role based security (fig.1; 0021, 0022, 0023).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 11, 14, 22, 25 and 33, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Ramachandran et al U.S. Patent Application Publication 2003/0083998.

Art Unit: 3621

8. As per **claim 3, 14 and 25**, Aldis et al failed to explicitly disclose the method, wherein the software license bank stores predetermined dollar amount of licenses.

Ramachandran et al discloses the method, wherein the software license bank stores predetermined dollar amount of licenses (0018, 0172).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores predetermined dollar amount of licenses in view of the teachings of Ramachandran et al in order to ease and estimate income by provider.

9. As per **claim 11, 22, and 33**, Aldis et al failed to explicitly disclose the method, wherein the web application stores configuration information for the computers running the licensed software.

Ramachandran et al discloses the method, wherein the web application stores configuration information for the computers running the licensed software (0031, 0068, 0072, 0073, 0109, 0118).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the web application stores configuration information for the computers running the licensed software in view of the teachings of Ramachandran et al in order to provide adequate security and ensure authorized users have access to licensed resources.

Claims 4, 6, 15, 17, 26 and 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Eng U.S. Patent Application Publication 2002/0169725.

10. As per **claim 4, 15 and 26**, Aldis et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined CPU count of software licenses.

Eng discloses the method, wherein the software license bank stores a predetermined CPU count of software licenses (figs. 1, 9 and 10, 0036).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores a predetermined CPU count of software licenses in view of the teachings of Eng in order to track license usages.

11. As per **claim 6, 17 and 28**, Aldis et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined user count of software licenses.

Eng discloses the method, wherein the software license bank stores a predetermined user count of software licenses (figs. 1, 9 and 10, 0036, 0052).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method

Art Unit: 3621

wherein the software license bank stores a predetermined user count of software licenses in view of the teachings of Eng in order to track license usages.

Claims **34, 35 and 36**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Ross et al U.S. Patent No. 5,553,143.

12. As per **claims 34, 35 and 36**, Aldis et al failed to explicitly disclose a system wherein the software is downgraded.

Ross et al discloses a system wherein the software is downgraded ().

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software is downgraded in view of the teachings of Ross et al in order to scale down software features as desired by the user and/or save cost of licensing.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Milstead U.S. Patent 6,345,256 is a document considered relevant to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(571) 273-8300. [Official communications; including After Final communications labeled "Box AF"].

Art Unit: 3621

(571) 273-8300. [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

Hand delivered responses should be brought to the United States Patent and
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Alexandria VA. 22314

Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621
March 15, 2006

Walla Lane T.
PRIMARY EXAMINER